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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/410,368	09/30/1999	JOHN R. HAVENS	244/006	6760

7590 07/01/2002  
LYON & LYON LLP  
633 W FIFTH ST  
SUITE 4700  
LOS ANGELES, CA 90071

EXAMINER

MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 07/01/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/410,368

Applicant(s)

Havens et al.

Examiner

Ardin Marschel

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 19, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19, 21-26, 28-39, and 67-89 is/are pending in the application.
- ~~And of the above, Claim(s) 20, 27, and 40-66 have been canceled. (See related drawing from a cancellation.)~~
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19, 21-26, 28-39, and 67-89 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jan 23, 2002 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submissions, filed on 1/23/02 and 4/19/02, have been entered.

Applicants' arguments, filed 1/23/02 and 4/19/02, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims 1-19, 21-26, 28-39, and 67-89 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is noted that the claims have been amended to add addressing by the application of an electronic potential which is NEW MATTER. The below explanation in the 35 U.S.C. § 112, second

paragraph, rejection summarizes the lack of a clear and concise connection between addressing and electronic potential and the presence of NEW MATTER as a result and is reiterated here as sufficiently also explaining this NEW MATTER issue. It is emphasized that a definition of a phrase must be present as filed and that adding it in amendments via arguments after filing is NEW MATTER.

Claims 1-19, 21-26, 28-39, and 67-89 are rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This rejection is reiterated and maintained from the previous office actions, mailed 10/23/01 and 3/25/02. Applicants argue that the phrase "electronically addressable" is defined in the specification via citing several sections regarding its alleged definition. Firstly, it is noted that none of the citations set forth by applicants state the clear and concise phrase "electronically addressable is defined as...". Instead all of the pointed to citations in P/N 5,632,957 are worded as characterizing electronically addressable locations etc. without noting that said characterizing "is" the electronically addressable character of the location etc. Therefore the wording of these citations is reasonably interpreted as defining

properties beyond and separate from the electronically addressable character per se. For example, applicants firstly argue that columns 7-9 of said Patent describe particular locations associated with an electrode, a permeation layer, and attachment regions, which "when activated" generate free field electrophoretic transport. Nowhere in this citation is there the statement that these limitations "are" electronic addressability. It is noted that arguments state this, but the definition must come from the application as filed or appropriate priority documents such as said Patent and not by after filing arguments. Alleging a definition in arguments after filing to clarify a definition is only that: an allegation. Note that this defining of a phrase after filing via amendments in claims has been noted above as being NEW MATTER. Applicants argue further that "other addressable locations" are defined as referring to microlocations where molecules and analytes are transported using electric field transport. Again applicants define this as addressable but again without this being defined as such in the citations in column 9 of said Patent. Applicants argue that this definition is only logical. This need for logic in order to define a term is at least one step removed from a clear and concise definition of a term or phrase as required under 35 U.S.C. § 112, second paragraph, and supports this rejection. Applicants go on to cite passages in columns 4-6 of said Patent regarding electronic

control for the transport and attachment of specific binding entities. Again there is no statement in said citations that the cited electronic control "is" electronic addressability. Applicants further argue that control of pH and binding entity movement and electronic potential are all what is meant by "electronically addressable". Again this is a set of connections to "electronically addressable" which have been provided in arguments after filing and thus non-persuasive as to being the actual definition of the phrase "electronically addressable". A suggestion to applicants is that the application of potential or electric fields for entity movement, the control of pH, and electrophoretic transport are all limitations which themselves are well defined in the specification and also common terminology which seems to be what applicants deem to define the operation of the claimed devices etc. Thus, a suggestion is to remove the unclear and severable phrase "electronically addressable" from the claims and either replace or leave claim wording regarding electric field movement or transport or pH control to result in clear and concise claim wording. With both "electronically addressable" as an undefined phrase along with these other limitations applicants are apparently setting forth claim wording which includes unclear severable terminology which is still the basis for this rejection. Alternatively, if applicants continue to set forth both the phrase and their alleged definition in the

claims, it is unclear what is gained by the apparent redundancy of wording. Clarification via clearer claim wording is requested.

No claim is allowed.

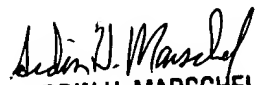
Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

June 28, 2002

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER